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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,683	03/29/2005	Jozef Pieter Van Gassel	NL 020935	1701
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EXAMINER HARVEY, DAVID E				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,683

Applicant(s)

VAN GASSEL ET AL.

Examiner

DAVID E. HARVEY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. **Preface:**

A) Lines 11-14 of claim 1 recite:

“characterized in that the first recording medium is being replaced by the second recording medium during a period between the first segment and the second segment when the data in the data stream is not intended to be recorded.”(emphasis added)

It is the examiner position that this “functional” recitation represents little more than a recitation of intended use; i.e., the recitation:

- 1) Fails to positively recite a step or steps which comprise the recited method of claim 1;
- 2) Fails to further define/characterize those steps which have been positively set forth in lines 4-10 of claim 1.

B) The examiner takes a similar position with respect to the ***“characterized in that...”*** recitations set forth in claims 2-12.

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2. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) In claim 1, lines 13-14, the recitations “*not intended to be recorded*” is indefinite because it is not clear what is meant by an “*intent*” to record and thus it is not clear what falls within the scope of this recitation and what falls outside the scope of this recitation. Clarification is needed. Similar clarification is needed with respect to the “intent” to record recited in lines 4-5 of claim 2.

B) In claim 13, line 2, “one of” should be deleted.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document #JP 405174447 A to Suzuki (machine generated translation provided) in view of Japanese Patent Document #JP 408031045 A to Uto et al. (machine generated translation provided).

A) The showing of Suzuki:

As shown in figure 1, Suzuki describes a system which comprises:

1) A video recorded for recording incoming television programming (not shown in the figure);

2) A video tape changing mechanism (@ 7 of Figure 1) for automatically replacing a "first" video tape recording medium that is currently loaded in the video recorded with an "second" blank video tape recording medium when the remaining/available recording space on the first loaded recording medium is detected (via elements 2-6 of Figure 1) as falling below a calculated level/threshold;

characterized in that the first medium is replaced by the second medium during a commercial break that is not "intended" for recording.

[Note: paragraphs 0004, 0005, 0008, 0009 and 0015 of the attached translation]

B) Differences:

Claim 1 differs from the showing of Suzuki only in that Suzuki does not describe the circuitry/process used to record the incoming television programming as including a buffer for buffering the incoming television programming during the replacing of the recording mediums.

C) The showing of Uto et al.:

As seems to be acknowledged by applicant [Note lines 1-20 on page 1 of the instant specification], the examiner contends that it was well known in the program recording art for program recording circuitry to have comprised a buffer for buffering the incoming program stream during the changing of the recording medium to prevent any data from being lost. The prior art of Uto et al. is hereby provided as an illustration of such conventional circuitry [SEE: Figure 1; and paragraphs 0011, 0015, 0016, and 0017 of the attached translation]. Further, Uto et al. also evidences the obviousness of having applied such recording techniques to other well known types of recording devices/mediums including digital recording devices/mediums [Note paragraph 0034 of the attached translations].

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D) Obviousness:

The examiner maintained that it would have been obvious to have implemented the video recording device/process in the system disclosed by Suzuki using the recording system/process illustrated in Figure 1 of Uto et al. The examiner maintains that the modified system would have advantageously prevented desired/"intended" programming data from being lost when the actual period between commercial breaks is longer than the calculated period (i.e., motivation for the modification).

6. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document #JP 405174447 A to Suzuki in view of Japanese Patent Document #JP 408031045 A to Uto et al. for the same reasons that were set forth above with respect to claim 1.

7. Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document #JP 405174447 A to Suzuki in view of Japanese Patent Document #JP 408031045 A to Uto et al. for the same reasons that were set forth above with respect to claim 1.

Additionally, the following is noted:

1) With respect to claim 2:

In the modified system, the commercial messages constitute the programming that is not intended for recording (i.e., to be cut) and the TV programming constitutes the programming that the user desires/intends to have recorded

2) With respect to claim 3:

In the modified system, the commercial messages are advertisements.

3) With respect to claim 4:

In the modified system, the beginning of the commercial message inherently represent scene changes with respect to the programming in which they occur.

4) With respect to claim 5:

The examiner takes Official Notice that it was notoriously well known in the art for TV programming to have comprises a sports program. The examiner maintains that it would have been obvious for the programming in the modified system to have been of such conventional form; i.e., the examiner maintains that the recitation represent little more than a recitation of intended use (note too: paragraph 1 of this Office action).

5) With respect to claims 6-7:

The examiner takes Official Notice that it was notoriously well known in the art for TV programming to have comprises a sports program. The examiner maintains that it would have been obvious for the programming in the modified system to have been of such conventional form; i.e., the examiner maintains that the recitation represent little more than a recitation of intended use (note too: paragraph 1 of this Office action). The examiner also takes Official Notice that it was notoriously well known in the art for commercial messages to have occurred during injury timeouts of such sports program (e.g., football games). The examiner maintains that it would have been obvious for the programming in the modified system to have been of such conventional form; i.e., the examiner maintains that the recitation represent little more than a recitation of intended use (note too: paragraph 1 of this Office action).

6) With respect to claim 8:

The examiner takes Official Notice that it was notoriously well known in the art for TV programming to have comprised programming followed by credits. The examiner maintains that it would have been obvious for the programming in the modified system to have been of such conventional form; i.e., the examiner maintains that the recitation represent little more than a recitation of intended use (note too: paragraph 1 of this Office action).

7) With respect to claim 9:

The examiner takes Official Notice that it was notoriously well known in the art for TV programming, in the digital domain, to have been broadcast with a greater resolution than the commercial messages (i.e., greater effective bit rate). The examiner maintains that it would have been obvious for the programming in the modified system to have been of such conventional form; i.e., the examiner maintains that the recitation represent little more than a recitation of intended use (note too: paragraph 1 of this Office action).

8) With respect to claim 10:

The examiner takes Official Notice that it was notoriously well known in the art for TV programming to have comprised/represented musical performances and for the commercial messages to have occurred between respective "songs" of the program. The examiner maintains that it would have been obvious for the programming in the modified system to have been of such conventional form; i.e., the examiner maintains that the recitation represent little more than a recitation of intended use (note too: paragraph 1 of this Office action).

9) With respect to claims 11 and 12:

The examiner takes Official Notice that it was notoriously well known in the art for TV programming recording art to have uses information obtained from EPGs to identify the programming that it to be recorded and the commercial messages that are to be cut/deleted. The examiner maintains that it would have been obvious to have further modified the

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system disclosed by Suzuki to detect/discriminate the commercial message periods (e.g., @ 2 of Figure 1) using such known methods/techniques.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsha D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY
Primary Examiner
Art Unit 2621